

REQUEST FOR RECONSIDERATION

Independent Claim 1 is drawn to a toner that must comprise a binder resin. The binder resin recited in present Claim 1 comprises a crystalline polyester and a non-crystalline resin. Applicants have disclosed that toners that include only a crystalline resin are unable to provide good low temperature fixability (page 5, lines 19-21). Likewise, the presence of only a non-crystalline resin has similar drawbacks (page 5, lines 9-17). Applicants address the problems of prior art toners by disclosing, in one aspect of the invention, a toner that includes a binder resin containing each of a crystalline polyester resin and a non-crystalline resin (page 7, lines 12-19).

Applicants draw the Office's attention to new dependent Claim 28 wherein the metal-containing material comprises an iron oxide and has a specific surface area of from 1.3 to 80 m²/g.

Applicants note that the presence of inoperative embodiments within the scope of a claim does not necessarily render a claim nonenabled (see MPEP § 2164.08(b)). The present specification on page 16 includes a description of methods for determining whether a toner is operative; namely, whether the toner has sufficient fixability and/or blackness. Applicants submit that such properties are readily determinable by those of ordinary skill in the toner art and that undue experimentation is not necessary to determine whether a particular toner is commercially useful.

MPEP § 2164.08(c) recognizes that a claim should be rejected under the enablement requirement if a critical feature is omitted. The present specification does not state that a particular limitation regarding specific surface area is critical for the invention to function as intended. In fact, the specification in paragraphs bridging pages 16 and 17 states the following:

The specific surface area of the metal-containing material for use in the toner of the present invention is preferably from 1.3 to 80 m²/g, and more preferably from 1.5 to 30 m²/g, in view of dispersibility of the material in the toner. When the specific surface area of the metal-containing material is too large, the low temperature fixability cannot be imparted to the resultant toner depending on the addition quantity of the material. This is because the black metal-containing material serves as a filler like carbon blacks. In contrast, when the specific surface area is too small, high blackness cannot be imparted to the resultant toner.

Thus, the specification merely states that low temperature fixability cannot be imparted if the specific surface area is too large and that high blackness cannot be imparted if the specific surface area is too low. The specification does not state that low temperature fixability or high blackness is critical for the invention to function as intended.

The Office rejected the present claims as anticipated by a publication to Sawada (U.S. 2002/132177). Applicants traverse the rejection on the grounds that Sawada does not disclose a toner that includes a binder resin that has both of a crystalline polyester and a non-crystalline resin. The binder resin of Sawada is described in, for example, paragraph [0106]. Sawada does not disclose a binder resin that contains each of a crystalline polyester and a non-crystalline resin.

Because Sawada does not disclose all of the present claim limitations, Sawada cannot anticipate the presently claimed subject matter. Applicants thus respectfully request withdrawal of the rejection in view of Sawada.

Applicants draw the Office's attention to new dependent Claims 23 and 24 wherein the amount of the crystalline polyester must be less than 50% or from 3 to 30% by weight, respectively. Crystalline polyester resins are described in the present specification on page 22, line 12 through page 24, line 4. Non-crystalline resins are described beginning at page 24, line 5 through page 25, line 13.

Applicants request the withdrawal of the rejections in view of Sawada.

The Office objected to the recitation of negative color values in some of the presently pending claims. Applicants submit that negative color values (i.e., negative values of L^* , a^* and b^*) are common. For example, it is readily known that the L, a, b color space is a three-dimensional color space wherein L is from 0 to 100 (e.g., light to black); negative and positive values of “ a ” represent green and red respectively; and negative and positive values of “ b ” represent blue and yellow respectively. Applicants draw the Office’s attention to <http://www.hunterlab.com/pdf/color.pdf> for a technical explanation of color measurement using the L, a, b system.

The Office rejected Claims 1-21 under obviousness-type double patenting in view of co-pending U.S. 10/800,636 (the ‘636 application). The obviousness-type double patenting rejection is a provisional rejection. Applicants request the Office hold the present obviousness-type double patenting rejection in abeyance pending mailing of Notice of Allowance in the present or co-pending application. Applicants draw the Office’s attention to MPEP § 804(I)(b) wherein it is stated:

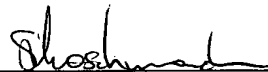
If the “provisional” double patenting rejections in both applications are the only rejections remaining in those applications, the Examiner should then withdraw that rejection in one of application (e.g., the application or the earlier filing date) and permit the application to issue as a patent. The Examiner should maintain the double patenting rejection in the other application as a “provisional” double patenting rejection which will be converted into a double patenting rejection when the application issues as a patent.

The filing date of the present application is earlier than the filing date of the co-pending ‘636 application.

For the reasons discussed above, Applicants respectfully request withdrawal of the rejections and the allowance of all non-pending claims.

Respectfully submitted,

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